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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,870	02/15/2000	Charles S. Vann	0550-0076.30	6464

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APPLIED BIOSYSTEMS
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EXAMINER

BEX, PATRICIA K

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 01/29/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/506,870	Applicant(s) VANN ET AL.	
	Examiner P. Kathryn Bex	Art Unit 1743	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): rejection of claims 21-25, 51-59 under 35 USC 2nd paragraph.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: 53 and 56.


Claim(s) rejected: 1-25, 48-52 and 54-55, 57-62.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 5. does NOT place the application in condition for allowance because: in response to the previous rejection of claims 1, 3, 6-7, 14-17 under 35 USC 102(b) as being anticipated by Eck (USP 4,685,480) Applicant argues that Eck does not disclose an apparatus capable of picking up a plurality of submillimeter beads from a bead supply and transferring the beads to a desired location. Examiner contends that the recitation of "transferring the beads to a desired location" has not been given patentable weight because a preamble is denied the effect of a limitation where the claims is drawn to a structure and the portion of the claims followign the preamble i a self-contained description of the structure, not depending for completeness upon the introductory clause, see Kropa v. Robie, 88 USPQ 478 (CCPA 1951). Additionally, Applicant argues that the device of Eck is for washing the wells 68 of the reaction tray 70 and the beads 7 contained within the reaction tray and is not capable of picking up the beads. Examiner does not agree since Figure 3 of Eck clearly shows the beads in fluidic contact with the vacuum source 14 via conduits 18. The beads are not shown in contact with the reaction well 68- but are drawn by the vacuum source into contact with the protrusions 60 of the cavity 58 (Fig. 3) such that wash liquid supplied from sprial channels 66 can flow underneath the beads 72 (column 3, lines 22-50). Therefore, the device of Eck is "capable of" transferring the beads to a desired location.

Continuation of 10. Other: Applicant believes the Final Rejection, mailed 10/09/02, is premature. Examiner does not agree since the amendment filed July 16, 2002 introduced limitations (e.g. upper ceiling regions defines a surface extending inwardly from said sidewall), previously unclaimed.


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